DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11 and 13-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

According to the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (1300 OG 142, 22 November 2005), the analysis for determining patent eligible subject matter under §101 can be said to be subject to the following criteria:

1. Does the claimed invention fall within one of the four statutory categories (process, machine, manufacture or composition of matter)? If the answer to this criterion is no, then the claimed invention is not statutory eligible subject matter.
2. If the answer is yes to the first criterion, then does the claimed invention fall within a judicial exception? If the answer to this criterion is no, then the claimed invention would be statutory eligible subject matter.
3. If the answer is yes to the second criterion, then does the claimed invention provide a practical application of the judicial exception? If the answer to this criterion is yes, then the claimed invention would be statutory eligible subject matter, unless the claimed invention effectively

preempts all substantial practical applications of the judicial exception, in which case the claimed invention would not be statutory eligible subject matter.

4. If the answer to the third criterion is no, then the claimed invention is not statutory eligible subject matter and is not eligible for patent protection.

With regards to the first criterion, the claimed invention is a teaching method comprising performing various steps in an attempt to enhance or facilitate discussion using bodily movements. Certainly, the steps recited can be considered a "process" and therefore broadly falls within one of the four statutory categories of invention.

However, regarding the second criterion it is well settled that claims directed to nothing more than abstract ideas, natural phenomenon, and laws of nature (i.e. judicial exceptions) are not eligible and therefore are excluded from patent protection. Diehr, 450 U.S. at 185, 209 USPQ at 7; accord, e.g., Chakrabarty, 447 U.S. at 309, 206 USPQ at 197; Parker v. Flook, 437 U.S. 584, 589, 198 USPQ 193, 197 (1978); Benson, 409 U.S. at 67-68 , 175 USPQ at 675; Funk, 333 U.S. at 130, 76 USPQ at 281. "A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right." Le Roy, 55 U.S. (14 How.) at 175. Instead, such "manifestations of laws of nature" are "part of the storehouse of knowledge," "free to all men and reserved exclusively to none." Funk, 333 U.S. at 130, 76 USPQ at 281. In this case, the method steps recited ("creating shapes", "connecting said shapes with transitions", framing questions in terms of said shapes", responding to said questions with bodily movements", verbally explaining",

etc.) are merely the manipulation of abstract ideas. It is the examiner's position that such manipulation of abstract ideas broadly falls into the above noted exclusions.

For claims including such excluded subject matter to be eligible, according to the third criterion the claim must be for a practical application of the abstract idea, law of nature, or natural phenomenon. Diehr, 450 U.S. at 187, 209 USPQ at 8 ("application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection."); Benson, 409 U.S. at 71, 175 USPQ at 676 (rejecting formula claim because it "has no substantial practical application"). A practical application of the § 101 judicial exception can be identified in various ways:

- The claimed invention "transforms" an article or physical object to a different state or thing; or
- The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

In this case, the recited steps do not result in a transformation of an article or physical object to a different state or thing. All that is claimed is a teaching method comprising creating abstract thoughts, moving one's body and oral expressions and discussions. While dependent claims 7 and 13 include documenting thoughts on a piece of paper, this is an incidental result of the method, and is not the claimed result of the process. Additionally, the mere display of abstract ideas does not amount to a physical transformation such that patentable subject matter is created. See In re Abele and Marshall, 214 USPQ 682 (C.C.P.A. 1982). The claimed end result of the process is teaching via discussions and body movements. This end result is not a transformation

of an article or physical object from a different state or thing. Therefore, the judicial exception recited in the claims is not practically applied via a transformation.

For eligibility analysis, physical transformation "is not an invariable requirement, but merely one example of how a mathematical algorithm [or law of nature] may bring about a useful application." AT&T, 172 F.3d at 1358-59, 50 USPQ2d at 1452. If the examiner determines that the claim does not entail the transformation of an article, then the examiner shall review the claim to determine if the claim provides a practical application that produces a useful, tangible and concrete result. In this case, it is the examiner's position that the claimed invention produces a result that is not useful, concrete and tangible. First, the claimed invention can arguably be considered to have a specific, substantial and credible utility. However, the claimed invention can not be said to produce a tangible result. Causing a group of participants to discuss questions and answers using bodily movement and oral expression is an abstraction that is not practically applied and cannot be considered a tangible result. Also, it is this examiner's position that the claimed invention does not produce a "concrete" result. The claimed method of fostering thinking is not sufficiently concrete because the claim requires such a degree of subjective human judgment that a reasonably consistent result cannot be predictably or reliably assured. How can a series of process steps ensure that teaching occurs among a group of participants? The claimed process steps cannot lead to fostered thinking in a group of participants in a reliable and repeatable fashion.

Therefore, since the claimed method does not result in a physical transformation and does not produce a useful, concrete and tangible result, it is this examiner's

position that the claimed judicial exception is not practically applied and is therefore not eligible for patent protection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Helen Landalf and Pamela Gerke, "Movement Stories for Children Ages 3-6" discloses a teaching method incorporating body movements. Stamm, French, Altman, Shepherd, Hodges, Kozak, Kole and Maiden-Nesset disclose various teaching methods.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (571) 272-4422. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kurt Fernstrom/
Primary Examiner, Art Unit 3711
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